



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,026	12/02/2003	Keita Ohshima	03500.017753.	4700
5514 7590 03/08/2011 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
RILEY, MARCUS T				
ART UNIT		PAPER NUMBER		
2625				
MAIL DATE		DELIVERY MODE		
03/08/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,026

Applicant(s)

OHSHIMA, KEITA

Examiner

MARCUS T. RILEY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is responsive to applicant's remarks received on December 29, 2010. Claims 41-45 are pending. Claims 1-40 have been cancelled.

Response to Arguments

2. Applicant's arguments with respect to newly added **claims 41-45**, filed on December 29, 2010 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 41-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (US 6,985,245 B1 hereinafter, Takahashi '245) in combination with Takahashi (US 6,727,999 B1 hereinafter, Takahashi '999).

Regarding claim 41; Takahashi '245 discloses an information processing apparatus (Fig.

- 1, Client Computers 103a-c) comprising:

a generating unit (Figs. 20 & 21, Property Keys 1607 or 1704)

configured to generate a job ticket (Fig. 22, Job Ticket 1801 i.e. Fig. 22, Job Ticket 1801 is displayed by actuating the property key 1607 or 1704 of the print driver of Fig. 20 or job submitter of Fig. 21, respectively. Column 23, lines 25-30)

for one-side printing (Fig. 22, Duplex "OFF" i.e. The duplex printing section can be set to OFF so that the OFF setting enables single-side printing. Column 23, lines 45-52),

wherein, in the job ticket, a plurality of sheets (Fig. 28, Sheets P1, P3, P6, P7 & P8)

are set to have respective color attributes (Fig. 19, Color Mode Setting 1506)

and a first sheet (Fig. 28, Sheet P1 i.e. Fig. 30 Step S2305) of the plurality of sheets is set to have a color attribute determined based on a color attribute of a first surface arranged on the first sheet (Fig. 30 Step S2302, S2305 and S2306 i.e. It is determined at a step 2302 whether or not the present page is colored, and if the page is colored, it is then determined whether or not the present page is the first page at Step S2305. Since the result of the determination at the Step S2305 is affirmative (Yes) in the first loop, the process proceeds to the step S2306 to create a new color job at Step S2306. Column 30, lines 29-49);

a changing unit (Fig. 22, Duplex "ON") configured to change one-side printing into both-side printing (Fig. 22, Duplex "ON" i.e. The duplex printing section can be set to ON so that the ON setting enables the duplex printing. Column 23, lines 45-52),

and an editing unit (Settings of Figs. 20, 21 & 22 i.e. The job ticket is edited by the settings and input by the user via the operation screens shown in Figs. 20, 21, 22. Column 23, lines 53-67) configured to edit the job ticket generated by said generating unit by changing the color attribute (Fig. 30, Step S2306) of the first sheet (Fig. 30 Step S2305) based on color attributes of both the first surface and a second surface arranged on the first sheet (Fig. 30 Step S2302, S2305 and S2306 i.e. It is determined at a step 2302 whether or not the present page is colored, and if the page is colored, it is then determined whether or not the present page is the first page at Step S2305. Since the result of the determination at the Step S2305 is affirmative (Yes) in the first loop, the process proceeds to the step S2306 to create a new color job at Step S2306. Column 30, lines 29-49);

where the color attributes are described in the job ticket for the one-side printing, without analyzing image data arranged on the first and second surfaces (Fig. 19, Color Mode Setting Button 1506 i.e. A user may select the Color MFP 104 or 105, the Color Mode Setting Button 1506 and the Property Key in order to set the printing conditions in the Job Ticket of Fig. 22 that may include the one sided printing, Duplex "OFF". Column 21, lines 27-63 and Column 22, line 54 thru Column 23, line 29);

in a case where the one-side printing is changed into the both-side printing by said changing unit (Fig. 22, Duplex "ON" i.e. The duplex printing section can be set to ON so that the ON setting enables the duplex printing. Column 23, lines 45-52).

Takahashi '245 does not expressly disclose the selection unit as claimed by Applicant. Although, Examiner believes Takahashi '245 inherently discloses this feature, it is not expressly stated.

For instance, Examiner believes Takahashi '245 discloses the selecting unit at (Fig. 21, Job Submitter 1701) configured to select a job ticket discrimination mode or an image data discrimination mode for color attribute determination wherein the job ticket discrimination mode is selected by said selecting unit. For example, Job Submitter 1701 is used for discriminating between the jobs and setting the detailed printing conditions in the job ticket for a destination device and Button 1703 may be used to discriminate between color MFP 104, 105, Printer 107 or MFP's 104 & 105.

Nevertheless, Examiner has cited Takahashi '999 that expressly discloses the selecting unit as claimed by Applicant.

Takahashi '999 discloses a selecting unit (Figs. 15, Print Job 1501) configured to select a job ticket discrimination mode or an image data discrimination mode for color attribute

determination (Figs. 15, Job Color Mode 1506 i.e. The job color mode column 1506 is capable of selecting one mode among automatic separation, manual separation, all color pages or all black/white pages. Column 23, line 29);

and where the job ticket discrimination mode is selected by said selecting unit (i.e. Button 1506 may be selected from the Selection unit 1501. Column 8, line 28-55);

Takahashi '245 and Takahashi '999 are combinable with because they are from same field of endeavor of network printer systems (See Takahashi '999, "Title").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the printer system as taught by Takahashi '245 by adding selecting unit as taught by Takahashi '999. The motivation for doing so would have been because there is a need to have an option to select and produce a high-quality document with different attributes. Therefore, it would have been obvious to combine Takahashi '245 with Takahashi '999 to obtain the invention as specified in claim 33.

Regarding claim 42; Takahashi '245 discloses a transmission control unit (Fig. 21, Job Submitter 1701) configured to transmit, based on the job ticket (Fig. 22, Job Ticket 1801) edited by said editing unit (Fig. 22, "OK" Button 1804 i.e. The user operates OK key 1804 to transmit the printing job including command data indicative of commands input by the user via the operation screens shown in Figs. 20, 21, 22, and other figures, image data to be printed. On receiving the printing job, the document server 102 controls the MFPs 104 and 105 to perform operations based on the commands from the user. Column 23, lines 53-67), one of the plurality of sheets (Fig. 28, P1, P3, P6, P7 & P8) whose color attribute is for color printing to a color printer (Fig. 28, Output to Color MFP 104) and another of the plurality of sheets (Fig. 28, Sheets P2, P4 & P5) whose color attribute is for monochromatic printing to a monochromatic printer (Fig. 28, Output to Monochrome MFP 105).

Regarding claim 43; Claim 43 contains substantially the same subject matter as claim 41. Therefore, claim 43 is rejected on the same grounds as claim 41.

Regarding claim 44; Claim 42 contains substantially the same subject matter as claim 42. Therefore, claim 44 is rejected on the same grounds as claim 42.

Regarding claim 45; Takahashi '245 discloses a non-transitory computer-readable storage medium for storing a program that causes a computer to execute the method (i.e. The system or the apparatus can enjoy the effects of the present invention by reading a program from a storage medium which program is expressed by software for attaining the present invention. Column 39, lines 15-22).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARCUS T. RILEY** whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus T. Riley
Assistant Examiner
Art Unit 2625

/MARCUS T. RILEY/
Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625